

### **REMARKS**

Claims 19-39 are pending. Claims 40-47 have been withdrawn as directed to non-elected subject matter. Claims 1-18 have been canceled by prior amendment. Favorable consideration of the currently pending claims is respectfully requested in light of the following remarks. No new matter is added.

#### **Restriction Requirement**

Claims 19-47 have been restricted between two different groups: Group I, which is drawn to a computer-implemented system or method (claims 19-39 of the application); and Group II, which is drawn to means or steps for communications between processes or application programs (claims 40-47 of the application). Applicants hereby elect Group II (claims 19-39) without traverse.

#### **Requirement for Information Under 37 C.F.R. § 1.105**

The examiner has also issued a Requirement for Information Under 37 C.F.R. § 1.105. Specifically, the Examiner has requested the following information:

1. The specific improvements of the subject matter in claims 19-47 over the disclosed prior art, and the specific elements in the claimed subject matter that provide the improvements. Specifically, the Examiner requests information pertaining to the paper process used by other insurance companies as well as Jefferson Pilot Financials in processing group insurance products; information on the improvements Jefferson Pilot has made to this paper process; and the differences between the manual/paper-based processes and the claimed "automated" process.

2. The portions of the disclosure that provide the written description and enablement support for the following specific claim elements and the intended meaning of the following claim limitations or terms:
  - a) Self-bill policies;
  - b) List-bill policies;
  - c) Contribution level;
  - d) Census letter;
  - e) Eligibility level; and
  - f) Participation level.

Applicants do not understand the rationale for this request. Applicants filed the present application on May 24, 2000, and in response to Office Actions Applicants have supplemented the file history with three Amendments to further assist the Examiner in determining the scope of the invention. In addition, with two of these Amendments Applicants provided detailed declarations by Sandra Callahan, one of the inventors of the present application. Accordingly, Applicants submit that the file history provides sufficient information to answer these questions.

Moreover, it does not appear to Applicants that any of the requested information falls under the categories of information for which 37 C.F.R. § 1.105 was intended to cover. See 37 C.F.R. § 1.105(a)(1)(i)-(vii).

Finally, it is noted that several of the Examiner's requests for information appear to be related to previous rejections of claims 19-32 under 35 U.S.C. § 101 as not being "within the technological arts." Applicants believe that, in view of the recent *Ex parte Lundgren* decision (Appeal No. 2003-2088 (Bd. Pat. App. & Int. 2005)), the rejections under 35 U.S.C. § 101 are no longer valid, which therefore obviates the need for any information related to the § 101 rejections.

Nevertheless, in order to expedite prosecution of the application Applicants respond with the following:

For the information requested in section 1., above, Applicants direct the Examiner's attention to the specification of the present application and the January 3, 2005 declaration of Sandra Callahan ("declaration"). Specifically, Applicants note that, at a minimum, paragraphs 5 and 10-14 of the declaration describe in detail the shortcomings of the paper-based processes and other processes used in the prior art, and describes the claimed elements which help overcome these shortcomings. Applicants also note that, at a minimum, paragraphs 14-17 describe the differences between the claimed invention and the prior art processes, and the improvements and commercial success that the presently claimed process provides over the prior art.

For the information requested in section 2, Applicants direct the Examiner's attention to the written specification and drawings of the present application. Initially, Applicants note that the Examiner has requested written description and enablement support for the term "eligibility level." This term, however, is not recited in the claims of the present application. Applicants assume that the Examiner intended the request to refer to the claim term "eligibility letter," and Applicants will address the Examiner's request under this assumption.

In response to the Examiner's request for this information, Applicants specifically note that all of the claim terms (i.e., self-bill, list-bill, contribution level, census letter, eligibility letter, and participation level) are described, at a minimum, in the specification at pages 19-21. See, e.g., the description of the renewal download process 604 and the renewal process 606. These processes, and the claim terms at issue, are also illustrated in, e.g., Figs. 12 and 13A. Applicants therefore submit that, as applied to these claim terms, the

specification of the present application "contain[s] a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same" in accordance with 35 U.S.C. § 112, first paragraph.

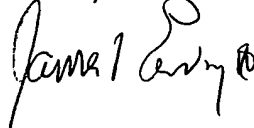
### **Conclusion**

Based upon the remarks provided above, applicants believe that Claims 19-39 are in condition for allowance. A Notice of Allowance is therefore respectfully solicited.

The Commissioner is hereby authorized to charge any additional fees that may be required, or credit any overpayment, to Deposit Account No. 11-0855.

If the Examiner believes any informalities remain in the application that may be corrected by Examiner's Amendment, or there are any other issues that can be resolved by telephone interview, a telephone call to the undersigned attorney at (404) 815-6500 is respectfully solicited.

Respectfully submitted,



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